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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,074	07/10/2001	Daisuke Kanenari	P100021-00055	7087

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EXAMINER

BERNATZ, KEVIN M

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,074

Applicant(s)

KANENARI ET AL.

Examiner

Kevin M Bernatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendments to the specification and claims 1, 3 and 4, filed on July 9, 2003, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. Applicant's election of Group I, claims 1- 4 in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

4. Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09-143306 A (JP '306 A) in view of JP 08-269241 A (JP '241 A), Saito et al. ('570) and Teramoto et al. ('865) for the reasons of record as set forth in Paragraph No. 19 of the Office Action mailed on March 6, 2003 (Paper No. 3).

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5. Claims 1 - 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09-143306 A (JP '306 A) in view of JP 08-269241 A (JP '241 A), Saito et al. (570) and Horowitz et al. ('090) for the reasons of record as set forth in Paragraph No. 20 of the Office Action mailed on March 6, 2003 (Paper No. 3).

Response to Arguments

6. The rejection of claims 1, 3 and 4 under 35 U.S.C § 103(a) – JP '306 A in view of JP '241 A, Saito et al. and Teramoto et al.

The rejection of claims 1 - 4 under 35 U.S.C § 103(a) – JP '306 A in view of JP '241 A, Saito et al. and Horowitz et al.

Applicant(s) argue(s) that the bonding strength between the different rubber compositions is strengthened by the claimed invention, as shown in examples 1 and comparative example 1, and that the limitations in claims 3 and 4 result in improvements over the art, as shown in examples 3 and 4. The examiner respectfully disagrees.

Applicants appear to be arguing that the claimed invention produces unexpected results, however the Examiner notes that unexpected results must be compared versus the closest prior art and the claims must be commensurate in scope with the showing of unexpected results. Furthermore, applicant(s) are reminded that **a detailed description of the reasons and evidence** supporting a position of unexpected results must be provided **by applicant(s)**. A mere pointing to data requiring the examiner to ferret out evidence of unexpected results **is not sufficient** to prove that the results

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would be truly unexpected to one of ordinary skill in the art. *In re D'Ancicco*, 439 F.2d 1244, 1248, 169 USPQ 303, 306 (1971) and *In re Merck & Co*, 800 F.2d 1091, 1099, 231 USPQ 375, 381 (Fed. Cir. 1986). Specifically, the Examiner notes that it is unclear from the data in Table 1 as to which variable effects the argued "improvements", since several examples exhibit the same rating of properties with a wide variance in rubber composition and additives.

Applicants further argue that the claimed invention is patentable over the prior art since JP '306 disclose several additional additives and fails to teach a hydrogenated NBR composition, JP '241 "fails to teach or suggest that the rubber composition may be used as a good bonding rubber interlayer between a hydrogenated NBR rubber and a diene-based rubber" and includes a rubber that is "quite different from the diene-based rubber ingredients used in the bonding rubber composition (C) as claimed", and that the additional references to Saito et al., Teramoto et al. and Horowitz et al. either include additional components not claimed or fail to teach the same intended use as applicants. The Examiner respectfully disagrees.

In response to applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, the Examiner notes that applicants' claims utilize the transitional phrase "comprising" and are therefore open to additional components being present since the transitional phrase.

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With regard to the argument that JP '306 fails to teach the claimed hydrogenated NBR composition, the Examiner notes that proper motivation was provided to utilize a hydrogenated NBR composition taught by Saito et al. in the rejection of record. With regard to the argument that JP '241 fails to teach or suggest a rubber meeting the diene-based rubber ingredient, the Examiner notes that JP '241 A clearly teach using polybutadiene rubber (BR) which meets applicants' claimed limitations (*Paragraph 6 of Machine Translation*).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB
September 12, 2003



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700